Atty Dkt No. 2302-1631.20
PP1631.101
PATENT

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8/13/01 Susan LaMont
Date Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

BARNETT et al.

Serial No.: 09/610,313 Art Unit: 1633

Filing Date: July 5, 2000 Examiner: B. Whiteman

Title: POLYNUCLEOTIDES ENCODING ANTIGENIC HIV TYPE C POLYPEPTIDES, POLYPEPTIDES AND USES THEREOF

AMENDMENT TRANSMITTAL LETTER

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith for filing is an amendment in the above patent application in response to the Office Action of July 13, 2001.

_ Petition for Extension of Time enclosed.

X No additional fee is required.

X Also enclosed: postcard

No. of Claims After Amendment			Most Claims Previously Paid		Extra Claims				Additional Fee
A. Total Claims		-		=		x	$18	=	$
B. Ind. Claims		-		=		x	$80	=	
C. If amended to contain multiple dependent claims, add 270							$270	=	$
D. Total Amendment Fee (Total of A, B & C)								=	
E. If small entity, 50% reduction of Total Amendment Fee (50% of D)								=	

F. Total Amendment Fee (D minus E)	=	$

___ A check for $ to cover the extension of time fee and extra claims fee is attached.

___ Charge $ to Deposit Account No. 18-1648.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 18-1648.

Respectfully submitted,

Date: Aug 13, 2001

By: D Pasternak

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Atty Dkt No. PP-1631.101
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Davis
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RESPONSE TO REQUIREMENT FOR RESTRICTION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Restriction Requirement dated July 13, 2001 (Paper No. 6), for which a response is due on or before August 13, 2001. Accordingly, this response is timely filed. The Examiner therein required election of one of the following groups of claims:

Groups I, II and III: Claims 1-40 and 42-47, drawn to an expression cassette comprising polynucleotide sequences encoding Pol polypeptides; and

Group IV, V and VI. Claim 41, drawn to a method of generating an immune response in a subject.

Applicants hereby elect to prosecute the claims of Group I, claims 1-40, 42-47 (SEQ ID NO:30), **with traverse**. In support of the restriction requirement, the Examiner asserts that the claims of each group are unrelated. However, Groups I, II and III are all made up of claims 1-40 and 42-47 and Groups IV, V and VI are all claim 41. Therefore, Applicants can only conclude that the assertion that these Groups are "unrelated" is based on sequences recited therein. Although the sequences may indeed be different, they are clearly "related" – all sequences are at least 90% homologous and all encode HIV Pol polypeptides.

Further, Groups I through III are all classified in Class 435, subclass 320.1, class 514, subclass 44 in the U.S. Patent Classification System. Similarly, Groups IV through VI are all classified in Class 435, subclass 70.1, class 514, subclass 12. Therefore, Groups I through III and IV through VI, respectively, are subject to all the same definitions, rules and, moreover, searches. Accordingly, they should be examined together and it would not constitute an undue burden for the Examiner to do so.

Applicants note that the MPEP clearly states that where the claims define the same essential characteristics of a single disclosed embodiment of an invention, varying in scope or breadth of definition of the same disclosed subject matter, a restriction requirement is improper. (see, MPEP 806.03) As discussed above, Groups I through III define essentially the same subject matter as do Groups IV through VI, **as evidenced by the classification**. Thus, applicants submit that the Restriction Requirement be redefined to combine Groups I to III, drawn to polynucleotide sequences encoding Pol polypeptides, and to combine Groups IV to VI, drawn to methods for generating an immune response using these sequences. As acknowledged by the Examiner, the search required for these Groups is the same and, indeed, Applicants have provided the sequences on which to base these searches. Therefore, examination of these allegedly distinct inventions in one application would not only not place an undue burden on the Examiner, but would actually save the Examiner time.

Applicants expressly reserve their right under 35 USC §121 to file one or more divisional applications directed to the nonelected subject matter during the

pendency of this application. Further, should the Examiner make the requirement final, Applicants reserve the right to appeal.

In response to the species election requirements, Applicants elect mammalian cells (claims 9, 17, 19, 20 and 21) of generic claim 8. It is to be understood that this election of species is for the purposes of preliminary search and examination only, and that upon allowance of a generic claim, applicants will be entitled to consideration of claims to the additional species.

The proposed groupings of the claims are confusing and any determination of distinctness of independence of the claimed invention(s) by the Examiner may have later ramifications during prosecution of this and related applications. For example, Applicants cannot understand what ramifications the proposed restriction requirement would have relative to double patenting issues during prosecution of the non-elected claims if they were filed and prosecuted in related applications (see, MPEP 806). **Further clarification is respectfully requested before the Examiner takes further action in this application. The Examiner is requested to review Applicants' traverse of the restriction requirement and to contact the Applicants.**

Respectfully submitted,

Date: Aug 13, 2001

By: D Pasternak
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